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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,805	12/05/2003	Richard Spear	SPETF / 040P2	1934
29360	7590	10/01/2004	EXAMINER	
GRAYDON HEAD AND RITCHEY LLP 1900 FIFTH THIRD CENTER 511 WALNUT STREET CINCINNATI, OH 45202			DAVIS, CASSANDRA HOPE	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,805

Applicant(s)

SPEAR ET AL.

Examiner

Cassandra Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed March 29, 2004 and June 3, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to in the Other Document Section has not been considered because the has not provide a copy of the items listed..

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13, and 17, respectively of copending Application No. 10/350,594 in view of Kremen, U. S. Patent Application Publication 2002/0029635. The present application teaches a label comprising: a facestock layer 12 having a first side and a second side; visible indicia

14, 16, 18 selectively applied to one or more portions of at least one of said first and second sides of said facestock layer; and at least one tactile coating layer selectively applied to discrete portions of said first side of said facestock layer to create distinct raised portions on the label for tactile feel. The present application does not recite that the tactile are in the form of embossed areas formed in the facestock. Kreman teaches a measuring device having indicia 26 in the form of printed markings, embossments (protrusions) or indentations placed onto the cup 20, by conventional printing, embossing or indentation techniques, so as to be visible and/or tactile. It is obvious that the embossed area of the label taught in copending application 10/350,594 form a tactile area because the raised portion formed by the embossment are perceptible to the touch.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10, 11, 14-16 are rejected under 35 U.S.C. 102(b) as being antecedent basis by Bright, U. S. Patent 5,753,350. Bright teaches a label 60 comprising a facestock layer having a first and second side, visible indicia 68 on a first side of the facestock layer and tactile coating 70 in the form glue droplets 136 on the first side. The

label taught by Bright is adhesively attached to a container such as a box, bottle or can. (Column 3, lines 39-40 and lines 51-61).

3. Bright also teaches a method for making the label comprising a providing a continuous label of stock material, applying glue droplet 136 to the substrate to form the tactile markings, cutting the stock material into labels. (Column 56-65).

4. Claims 1, 3, 4, 5, and 12 rejected under 35 U.S.C. 102(b) as being antecedent basis by Barr, U. S. Patent 3,667,759. Barr teaches a deck or stack of playing cards comprising a substrate or facestock 10, a visible indicia 11 and 12 applied to a first surface of the substrate 10, and transparent layer attached to the first surface of the substrate 1 and having indicia 21 and 22 which are in bas-relief and corresponding to the indicia 11 and 12 in character and position.

5. With respect to claim 3, the relief indicia 21 and 22 are aligned with the printed indicia 11 and 12.

6. With respect to claim 4, the layer 20 is made of a transparent plastic material. (Column 2, lines 27-31).

7. Claims 1, 3-6 are rejected under 35 U.S.C. 102(b) as being antecedent basis by Britt et al., U. S. Patent 4,401,050. Britt teaches an adhesive indicator comprising an elongated transparent tape substrate 12 having a front and rear second side, visible indicia 18 on a rear side 18 of the substrate 12 and raised tactile area 14 on the front side. The indicator taught by Britt is adhesively attached to a support utilizing adhesive layer 20 on the rear side.

8. With respect to claims 3 and 5, the visible indicium is a phosphorescent substance aligned with the raised tactile area 14. (Figure 2).
9. The transparent tape is made of plastic or Mylar material.
10. Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 102(b) as being antecedent basis by Sokyrka, U. S. Patent 5,512,122. Sokyrka teaches three-dimensional sign comprising a substrate 12 having a first and second side, visible indicia 22, and tactile layer 18 and 20.
11. With respect to claim 2, Sokyrka also teaches a primer (not labeled) applied to the surface of the substrate to which the printing compound 18 and 20 will adhere. (column 2, lines 45-50).
12. With respect to claim 3, the printed color layer 22 is aligned with the tactile layer 20. (column 2, lines 66-67 and column 3, lines 1-14).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright '350.
15. Since the applicant does not disclose that constructing the facestock of cellophane solves any stated problem or is for any particular purpose, it appears that

constructing the facestock of any suitable plastic transparent material would perform equally well.

16. Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright, U. S. Patent 6,287,671 teaches a transparent label having visible indicia thereon. (See column 19, lines 14-16).

17. Since the applicant does not disclose that constructing the facestock of cellophane solves any stated problem or is for any particular purpose, it appears that constructing the facestock of any suitable plastic transparent material would perform equally well.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barr.

19. With respect to claim 4, since the applicant does not disclose that constructing the facestock of cellophane solves any stated problem or is for any particular purpose, it appears that constructing the facestock of any suitable plastic transparent material would perform equally well.

20. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sokyrka in view of Bright '350. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the sign or lettering taught by Sokyrka with adhesive as taught by Bright on the rear surface to provide means to adhere it to a support surface such as container to provide a means to label the support or container.

21. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Britt. Since the applicant does not disclose that constructing the facestock of cellophane

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solves any stated problem or is for any particular purpose, it appears that constructing the facestock of any suitable plastic transparent material would perform equally well.


22. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bright '350 in view of Sokyrrka. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the label taught by Bright with a primer on the facestock or substrate as taught by Sokyrrka to provide a means to which the printing will adhere.

23. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barr in view of Sokyrrka. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the cards taught by Barr with a primer on the facestock or substrate as taught by Sokyrrka to provide a means to which the printing will adhere.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 703-308-2223. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cassandra Davis
Primary Examiner
Art Unit 3611

CD
September 22, 2004